



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Pet. Sec.

Mailed: JUL 14 2004

BC
Paper Number

In re application of
Shigeto Fujimura et al.
Serial No. 09/753,662
Filed: January 4, 2001
For: PROCESS FOR PRODUCING COMPOUND SEMICONDUCTOR
CRYSTAL

DECISION ON
PETITION

This is a decision on PETITION UNDER 37 C.F.R. 1.59(b), filed on November 21, 2003, requesting that the Office Action mailed on August 21, 2003 be withdrawn. The Petitioner submits that the examiner abused his discretion in reopening prosecution in the above-identified application when no new issue was presented in the Office Action to warrant pulling the above-identified application from appeal. As detailed on pages 2 and 3 of the pending Petition, this is the second occasion in which the examiner reopened prosecution after an Appeal Brief was filed. In the later instance, the examiner applied the same art in essentially the same manner, except for the addition of a nominal sentence in the rejection body on page 4 of the Office Action. The Petitioner contends that no new issue was presented in the August 21, 2003 Office Action.

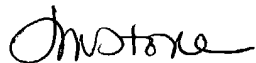
DECISION

37 CFR 1.59(b) allows for an Applicant to request that the Office expunge and return information, other than what is excluded by paragraph 37 CFR 1.59(a)(2), i.e. information forming part of the original disclosure, by filing a petition. MPEP 724.05 provides examples of such papers that may be expunged from the official record, which includes proprietary/trade secret information, information unintentionally submitted in an application and information submitted in an incorrect application. In the present case, the Petitioner is requesting that a paper that was clearly intended to be made part of the official record be expunged, which does not fall within the guidelines set forth in MPEP 724.05. Accordingly, the Office Action mailed on August 21, 2003 cannot be expunged.

The Petition under 37 CFR 1.59(b) is **DENIED**.

It is agreed that the second reopening of prosecution with the issuance of the August 21, 2003 Office action was inappropriate, as it simply clarified the examiner's position regarding the pending art rejections. As the Applicants have filed a supplemental Appeal Brief concurrent

with this Petition, such will be promptly addressed by the examiner. The examiner is herein directed to prepare and Examiner's Answer in this application as the next order of business.

A handwritten signature in cursive script, appearing to read "JStone", positioned above a horizontal line.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Marc S. Weiner
BIRCH, STEWART, KOLASCH AND BIRCH, LLP
P.O. Box 747
Falls Church, VA 22040-0747